

Application No: 10/069,432
Response to 11/04/2003 Office Action

REMARKS/ARGUMENTS

35 U.S.C. § 103

Claims 1-6 have been rejected under 35 U.S.C. § 103 as being obvious over Elliott in view of Peterson. This rejection is respectfully traversed for the following reasons.

Elliott is applied as disclosing a process for making a conveyor belt wherein the edges of the belt are restricted during curing. Elliott discloses applying a ribbon 28 from a supply coil 30 to the edges of an uncured belt; the ribbon 28 being removed from the belt edges following curing.

It is recognized in the Office Action that Elliott is silent about applying the ribbon 28 as a preform, "although it is noted Elliott discloses that restrictive preforms are well known in the art (Column 1, lines 51-55)" (Office Action, pg 3). Applicants disagree with this characterization of these teachings of Elliott. At column 1, lines 51-55, Elliott discloses that rectangular steel side bars or molded edge rings for use with a rotary mold are known to restrain the belt edges during curing. These are well known tools and side bars are also disclosed as prior art by Applicants (Spec. pg 1, lines 20-25). However, contrary to the Office Action, the side bars or molded edge rings are not preforms, "i.e. a material with a prefabricated channel" as defined in the Office Action. In flat press manufacturing, rectangular side bars are placed along the edges of the uncured belting laminate to limit the flow of the laminate during curing and to set the gauge of the press. Elliott himself states the bars are rectangular – thus, there is no prefabricated channel in the bar. Mold edge rings are similar to the side bars, but are used with rotary molds as shown in Fig. 2 of Elliott; the mold edge rings have an inner diameter matching the rotary press and an outer diameter that dictates the gauge of the press and stops the laminate from flowing out of the press during curing. Conventionally, neither of these molding tools have a prefabricated channel, and nothing in Elliott suggests otherwise.

To remedy the lack of the teachings of a preform by Elliott, the teachings of Peterson are applied. Peterson discloses a method for making brushes wherein a layer of brush material is permanently affixed with a channel C formed of "thin sheet metal capable of being deformed" (col 4, lines 2-4) wherein the walls of channel C are bent inward to "insure the *permanent retention* of the brush material in the base which such channel constitutes"

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(emphasis added; col 4, lines 14-24). Peterson teaches the thin sheet metal, prior to application about the edges of the brush material, may be "previously partially channeled or flat" (col 5, lines 35-36).

Under the standards established by *Graham v. Deere*, to establish *prima facie* obviousness, there 1) must be some suggestion or motivation in the art to modify or combine the references; 2) must be a reasonable expectation of success and 3) the combined references must teach or suggest all the claim limitations. The present rejection fails to meet all three of these requirements.

Most notably, there is no suggestion or motivation in either Elliot or Peterson to modify or combine the references. The reason, suggestion or motivation to combine [references] may be found explicitly or implicitly: (1) in the prior art itself; (2) in the knowledge of those of ordinary skill in the art that certain references are of special interest or importance in the field; or (3) from the nature of the problem to be solved. Wesley Jessen Corp. v. Coopervision Inc., 63 USPQ2d 1897, 1901 (US Central Ca, 2002) (Ruiz v. A.B. Change Co., 234 F.2d 654, 665 (Fed. Cir. 2000)). In determining relevancy of prior art, the court has previously stated "to be relevant, the area or art should be 'where one of ordinary skill in the art would be aware that similar problems exist.'" *Bott v. Four Start Corp.*, 218 USPQ 358 (D.Ct, ED Mich 1983)(citing *Stevenson v. ITC*, 204 USPQ 276, 280 (CCPA 179)).

Elliot is directed toward manufacturing a conveyor belt wherein an edging material is temporarily applied during curing to achieve a desired look in the finished belt. Peterson has absolutely nothing to do with manufacturing belts; he teaches a permanent edging material that is applied as an integral part of the finished product. There is no direct motivation in Peterson to use the preform of Peterson in Elliot as Peterson does not teach removing the material after assembly of the product and the products produced are completely dissimilar.

Regarding the relevancy of Peterson in looking to solve a problem in Elliot or to improve on the process of Elliot, since Elliot teaches a removable element, one skilled in the art would not find relevancy in a teaching wherein the element is not removable but is instead a permanent feature of the finished product. Elliot and Peterson are from entirely different art areas – this is evident in their USPTO classifications. Elliot is located in classes 264 and 425, while Peterson is solely located in class 300 – Brush, Broom and Mop Making. One skilled in the art looking to improve upon a conveyor belt construction would not be inclined

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to look to Brush, Broom, and Mop Making.

Under the second *Graham v. Deere* requirement of a reasonable expectation of success, it is uncertain that this is met. While Peterson teaches that the edge strip may be partially preformed as opposed to flat, one skilled in the art would question whether or not the edge strip should become a permanent part of the belt of Elliot.

The Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988)). It appear that Peterson is being applied solely in hindsight, using Applicants teachings to direct the Examiner to completely unrelated art and then use only a small portion of Peterson, completely discounting the entire teaching field of Peterson and its irrelevance to Elliot.

Claim 3 recites that after curing, the preform maintains or returns to its pre-formed u-shape. This is not disclosed in Elliot as modified by Peterson. The preformed taught by Peterson is not removed, and thus it is unknown if, upon removal, it would maintain or return to its original shape. As Peterson teaches further deformation of the channel to enclose the brush material, one skilled in the art would likely appreciate that return of the preform is highly speculative and unlikely.

Claim 5 recites a distance between the legs of the pre-form. Neither Elliot nor Peterson disclose such a distance of less than the thickness of the uncured laminate. Elliot, by way of Fig. 4 showing the belt prior to cure, suggests that the distance is greater for the majority of the its length. Peterson is silent on the issue, though Fig 3 suggests that the distance is equivalent.

Claim 6 recites that the preformed material is comprised of small prongs to bite into the laminate. Reference is made to Elliot's teaching of stapling the ribbon into place. However, the claim language recites that the preform is comprised of prongs, i.e. the prongs are an integral part of the preform, contrary to the use of a separate and distinct staple means to secure the ribbon of Elliot.

As Elliott in view of Peterson fails to establish *prima facie* obviousness of the invention as recited in claims 1-6, it is respectfully requested that the rejection be withdrawn.

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Cited Prior Art

While not obligated, as the art has not been used in a rejection, Applicants would like to comment on the additional art cited of record.

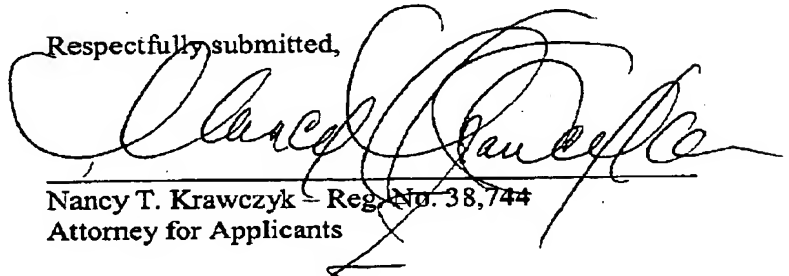
Holdsworth discloses the same subject matter as Elliot, and like Elliot, fails to disclose any preforming of the edge material applied.

Hillard refers back to Elliot for all relevant teachings of edge material, thus providing no additional teachings regarding the edge material.

Both references are merely duplicative of Elliot.

In light of the above remarks/arguments, Applicants believe all of the pending claims in the subject patent application are allowable. Thus, the Examiner is respectfully requested to allow all pending claims.

Respectfully submitted,



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